

### REMARKS

Reconsideration and allowance of the present patent application based on the following remarks are respectfully requested.

By this Amendment, claims 1, 16, 20, 23 and 24 are amended. Support for the amendments to the claims can be found throughout the original disclosure. For example, Examiner's attention is directed to paragraphs 26 and 34 of the present published application which provide support for "heating without reduction" and paragraph 35 the specification which provides support for "single walled carbon nanotubes." No new matter has been added. Claims 15 and 19 have been cancelled herein without prejudice or disclaimer to the subject matter recited therein.

Accordingly, after entry of this Amendment, claims 1, 7-17, 20 and 23-25 will remain pending in the present application.

#### Claim Rejections – 35 USC § 112

Claims 1, 7-17, 19-20 and 23-25 were rejected under 35 U.S.C. § 112, first paragraph. The Examiner contends that claim 1 contains the limitation that the catalyst is not pre-treated with hydrogen which is not supported in this specification.

To further advance prosecution of this Application, Applicant has amended claim 1 and deleted the limitation "wherein the catalyst is not pre-treated with hydrogen gas." Accordingly, the above rejection under 35 U.S.C. § 112, first paragraph is rendered moot.

#### Claim Rejections – 35 USC § 103

Claim 1, 7-13, 15-16, 19 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,333,016 to Resasco et al. (hereinafter "Resasco '016") in view of Weidenkaff et al., Mat. Sci. Engr. C19, pp.119-123, 2002 (hereinafter "Weidenkaff") and U.S. Patent Application Publication No. 2003/0086859 to Kawakami et al. (hereinafter "Kawakami"). Applicant respectfully traverse this rejection for at least the following reasons.

Claims 15 and 19 have been cancelled herein without prejudice or disclaimer to the subject matter recited therein. The subject matter recited in claims 15 and 19 is now captured in claim 1.

Applicant has further amended claim 1 to recite, *inter alia*, “before, during or after contacting the gaseous carbon source with the substrate particles, decomposing the transition metal formate or oxalate to yield the transition metal catalyst on the substrate particles by heating without reduction.”

Resasco '016 discloses a method of producing carbon nanotubes involving the step of forming a bimetallic catalyst *in situ* through decomposition of a precursor compound such as bis(cyclopentadienyl) cobalt or bis(cyclopentadienyl) molybdenum chloride (see, column 5, lines 26 to 29 in Resasco '016). As the Examiner acknowledges, Resasco '016 does not disclose, teach or suggest that the metal salt can be a formate or oxalate. In addition, Resasco '016 does not disclose, teach or suggest a nickel, iron or cobalt formate or oxalate. Furthermore, as acknowledged in the Office Action, Resasco '016 does not teach that the particles are fluidized.

Furthermore, the methods disclosed in Resasco '016 involve pre-treatment of the metallic catalysts with hydrogen gas before reacting the catalyst with a carbon source (see, for instance Examples 1 to 6 in cols. 8-11 in Resasco '016). Because Resasco '016 requires pre-treating with hydrogen (the hydrogen being a reductant), Resasco '016 clearly teaches the opposite of yielding a transition metal catalyst on the substrate particles by heating without reduction. Resasco '016 uses hydrogen which is known to be a reducing agent to pre-treat the bimetallic catalyst. Therefore, the methods in Resasco '016 involve pre-treatment of the bimetallic catalysts in a reducing environment containing hydrogen.

Weidenkaff fails to cure the deficiencies noted above in Resasco '016. Weidenkaff is directed towards a method of producing multi-walled carbon nanotubes (see, for example, the abstract in Weidenkaff). Indeed, the abstract in Weidenkaff states that “[t]he resulting multiwalled carbon nanotubes are several micrometers long with tube diameters ranging from 5 to 20 nm.” Whereas, claim 1 recites, *inter alia*, “the carbon nanotubes are single walled carbon nanotubes.”

One of ordinary skill in the art skilled would appreciate that the production of multi walled carbon nanotubes requires different catalysts and methods of production compared with the production of single walled carbon nanotubes. Therefore, one of ordinary skill in the art would not be motivated to use the teaching of Weidenkaff for the production of single-walled carbon nanotubes.

As discussed above Weidenkaff discloses a method for the production of multi-walled carbon nanotubes. In contrast, Resasco '016 is directed towards a method for the production of single-walled carbon nanotubes (see, for example, column 3 in Resasco '016).

There is no suggestion, motivation or reason to combine the teachings of Weidenkaff with the teachings of Resasco '016 as Resasco '016 and Weidenkaff are directed to different technical endeavors which use different methods and techniques. Indeed, Resasco '016 endeavors to produce single walled carbon nanotubes whereas Weidenkaff endeavors to produce multi walled carbon nanotubes.

Resasco '016 discloses an alternative method for the production of multi-walled carbon nanotubes that relates to the use of an arc discharge system comprising the use of electrodes or microwaves (column 6, lines 7 to 22). However, this method is not relevant to the claimed invention since claim 1 requires "single walled carbon nanotubes."

Even if one were to combine Resasco '016 and Weidenkaff, which Applicant does not concede, the result of the combination can only produce multi walled carbon nanotubes. Therefore, even if one were to combine Resasco '016 and Weidenkaff, the combination will be different from the subject matter recited in claim 1.

Furthermore, neither Resasco '016 nor Weidenkaff disclose, teach or even suggest that the carbon nanotubes are collected by elution.

The Examiner contends that Kawakami, in paragraph 162, explains that elution is a technique known to those of ordinary skill in the art for collecting nanoparticles. Applicant respectfully disagrees.

Paragraph 162 of Kawakami states the following: "Separately, the heat-treated nanocarbon product (b) was treated with hydrochloric acid then treated with nitric acid to elute and remove the nickel contained therein. The heat-treated nanocarbon product (b)

thus treated, was washed with ion-exchanged water and heat-treated at a temperature of 350°C. in an air atmosphere, whereby a powdery Ni-free nanocarbon product was obtained.” Kawakami does not disclose, teach or even suggest utilizing elution for collecting nanoparticles nor disclose, teach or suggest that elution is a technique known to those of ordinary skill in the art for collecting nanoparticles.

Applicant submits that elution is one of many methods that might be utilized to collect carbon nanotubes, the methods including filtering, trapping, or using a water-cooled surface to collect vaporised nanotubes, for example.

Applicant specifically used elution to collect carbon nanotubes as elution was determined to be effective in collecting carbon nanotubes produced with the method as claimed in claim 1. Applicant respectfully submits that utilizing elution for collecting nanoparticles does not form part of the skilled person's general knowledge. Accordingly, there is no suggestion, motivation or reason to modify Resasco '016 or Weidenkaff to include elution.

Moreover, there is no motivation or reason to utilize Kawakami in the collection of nanoparticles since Kawakami discloses a reaction process that is completely different from the method as claimed in claim 1.

Consequently none of Resasco '016, Weidenkaff and Kawakami, taken alone or in combination, disclose, teach or suggest the subject matter recited in claim 1.

Therefore, Applicant respectfully submits that claim 1 is patentable over the combination of Resasco '016, Weidenkaff and Kawakami.

Claims 7-13, 15-16, and 24 depend from claim 1. Therefore, claims 7-13, 15-16, and 24 are patentable by virtue of their dependency on patentable claim 1 and for the additional limitations recited therein. Thus, it is respectfully requested that the rejection of claims 1, 7-13, 15-16, 19 and 24 under 35 U.S.C. § 103(a) over the combination of Resasco '016, Weidenkaff and Kawakami be withdrawn.

Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Resasco '016, Weidenkaff and Kawakami in light of U.S. Patent No. 5,500,200 to Mandeville et al. (hereinafter “Mandeville”). Applicant respectfully traverses this rejection for at least the following reasons.

Claim 14 depends from claim 1. Therefore, for at least the reasons provided above with respect the claim 1, Applicant respectfully submits that claim 14 is patentable over the combination of Resasco '016, Weidenkaff and Kawakami.

Mandeville fails to overcome the deficiencies noted above in the combination of Resasco '016, Weidenkaff and Kawakami. Mandeville was relied upon as allegedly disclosing a method of forming carbon fibrils using fumed alumina as a carrier particle for the metal catalyst. Mandeville does not disclose, teach or suggest the subject matter recited in claim 1.

Consequently none of Resasco '016, Weidenkaff, Kawakami and Mandeville, alone or in combination, disclose, teach or suggest the subject matter recited in claim 14.

Therefore, Applicant respectfully submits that claim 14 is patentable over the combination of Resasco '016, Weidenkaff, Kawakami and Mandeville. Thus, it is respectfully requested that the rejection of claim 14 under 35 U.S.C. § 103(a) over the combination Resasco '016, Weidenkaff, Kawakami and Mandeville be withdrawn.

Claim 17 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Resasco '016, Weidenkaff and Kawakami in light of U.S. Patent No. 5,165,909 to Tennent et al. et al. (hereinafter "Tennent '909"). Applicant respectfully traverses this rejection for at least the following reasons.

Claim 17 depends from claim 1. Therefore, for at least the reasons provided above with respect the claim 1, Applicant respectfully submits that claim 17 is patentable over the combination of Resasco '016, Weidenkaff and Kawakami.

Tennent '909 fails to overcome the deficiencies noted above in the combination of Resasco '016, Weidenkaff and Kawakami. Tennent '909 was relied upon as allegedly disclosing a method of forming carbon nanotubes wherein iron oxalate is used as the metal salt for forming the catalyst. Tennent does not disclose, teach or suggest the subject matter recited in claim 1. Tennent '909 does not disclose, teach or suggest, *inter alia*, "before, during or after contacting the gaseous carbon source with the substrate particles, decomposing the transition metal formate or oxalate to yield the transition metal catalyst on the substrate particles by heating without reduction; forming

single walled carbon nanotubes by decomposition of the carbon source catalysed by the transition metal catalyst," as recited in claim 1.

Consequently none of Resasco '016, Weidenkaff, Kawakami and Tennent '909, alone or in combination, disclose, teach or suggest the subject matter recited in claim 17.

Therefore, Applicant respectfully submits that claim 17 is patentable over the combination of Resasco '016, Weidenkaff, Kawakami and Tennent '909. Thus, it is respectfully requested that the rejection of claim 14 under 35 U.S.C. § 103(a) over the combination Resasco '016, Weidenkaff, Kawakami and Tennent '909 be withdrawn.

Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Resasco '016, Weidenkaff and Kawakami in light of U.S. Patent No. 6,955,800 to Resasco et al. (hereinafter "Resasco '800"). Applicant respectfully traverses this rejection for at least the following reasons.

Claim 20 depends from claim 1. Therefore, for at least the reasons provided above with respect the claim 1, Applicant respectfully submits that claim 20 is patentable over the combination of Resasco '016, Weidenkaff and Kawakami.

Resasco '800 fails to overcome the deficiencies noted above in the combination of Resasco '016, Weidenkaff and Kawakami. Resasco '800 teaches a method for catalytic production of carbon nanotubes. Resasco '800 does not disclose, teach or suggest the subject matter recited in claim 1. In addition, Resasco '800 does not disclose the catalyst precursors recited in claim 1, instead Resasco '800 provides a similar disclosure in this regard as Resasco '016 (see, column 7, lines 32 to 35 in Resasco '800). In common with Resasco '016, the method of Resasco '800 involves exposing the catalytic particles to a reducing gas (hydrogen being the reducing gas) (see, column 3, line 65 to column 4, line 12 in Resasco '800). Thus, even if one were to combine Resasco '800 with Resasco '016 Weidenkaff and Kawakami, one of ordinary skill in the art would not achieve the method of production of carbon nanotubes claimed in claim 1.

Consequently none of Resasco '016, Weidenkaff, Kawakami and Resasco '800, alone or in combination, disclose, teach or suggest the subject matter recited in claim 20 which depends from claim 1.

Therefore, Applicant respectfully submits that claim 20 is patentable over the combination of Resasco '016, Weidenkaff, Kawakami and Resasco '800. Thus, it is respectfully requested that the rejection of claim 20 under 35 U.S.C. § 103(a) over the combination of Resasco '016, Weidenkaff, Kawakami and Tennent '800 be withdrawn.

Claim 23 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Resasco '016, Weidenkaff, Kawakami in light of U.S. Patent No. 6,290,775 to Kohlen et al. (hereinafter "Kohlen"). Applicant respectfully traverses this rejection for at least the following reasons.

Claim 23 depends from claim 1. Therefore, for at least the reasons provided above with respect the claim 1, Applicant respectfully submits that claim 23 is patentable over the combination of Resasco '016, Weidenkaff, Kawakami.

Kohlen fails to overcome the deficiencies noted above in the combination of Resasco '016, Weidenkaff, Kawakami. Kohlen was relied upon as allegedly disclosing fluidized bed reactors that can be arranged vertically or at an angle. Kohlen does not disclose, teach or suggest the subject matter recited in claim 1. Consequently none of Resasco '016, Weidenkaff, Kawakami and Kohlen, alone or in combination, disclose, teach or suggest the subject matter recited in claim 23 which depends from claim 1.

Therefore, Applicant respectfully submits that claim 23 is patentable over the combination of Resasco '016, Weidenkaff, Kawakami and Kohlen. Thus, it is respectfully requested that the rejection of claim 23 under 35 U.S.C. § 103(a) over the combination Resasco '016, Weidenkaff, Kawakami and Kohlen be withdrawn.

Claim 25 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Resasco '016, Weidenkaff, Kawakami in light of U.S. Patent No. 5,973,444 to Xu et al. (hereinafter "Xu"). Applicant respectfully traverses this rejection for at least the following reasons.

Claim 25 depends from claim 1. Therefore, for at least the reasons provided above with respect the claim 1, Applicant respectfully submits that claim 25 is patentable over the combination of Resasco '016, Weidenkaff, Kawakami.

Xu fails to overcome the deficiencies noted above in the combination of Resasco '016, Weidenkaff, Kawakami. Xu was relied upon as allegedly disclosing nickel formate can be used in place of nickel oxalate as the catalyst precursor. Xu does not disclose, teach or suggest the subject matter recited in claim 1. Consequently none of Resasco '016, Weidenkaff, Kawakami and Xu, alone or in combination, disclose, teach or suggest the subject matter recited in claim 25 which depends from claim 1.

Therefore, Applicant respectfully submits that claim 25 is patentable over the combination of Resasco '016, Weidenkaff, Kawakami and Xu. Thus, it is respectfully requested that the rejection of claim 25 under 35 U.S.C. § 103(a) over the combination Resasco '016, Weidenkaff, Kawakami and Xu be withdrawn.



**CONCLUSION**

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

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Respectfully submitted,

By:

  
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CHRISTOPHE F. LAIR  
Registration No. 54,248

**Customer No. 00909**

**PILLSBURY WINTHROP SHAW PITTMAN LLP**  
P.O. Box 10500  
McLean, Virginia 22102  
Main: 703-770-7900  
Direct Dial: 703-770-7797  
Fax: 703-770-7901